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Paper No. 6

The Whitaker Corporation
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Wilmington DE 19808

In re Application of
O'Toole, Levin, Edwards, Xu, Vandenberg, Markham
Application No. 09/901,293
Filed: July 9, 2001
Attorney Docket No. 17586A USA
For: OPTOELECTRIC MODULE FOR MULTI-FIBER
ARRAYS

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)
AND
DECISION ON PETITION UNDER
37 CFR 1.137(b)

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DEC 13 2002

OFFICE OF PETITIONS

This is a decision on the petition under 37 CFR 1.47(a), filed October 1, 2002.

This is also a decision on the petition under 37 CFR 1.137(b), filed October 1, 2002, to revive the above-identified application.

The petition under 37 CFR 1.47(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a) and Renewed Petition Under 37 CFR 1.137(b)."

This above-cited application became abandoned for failure to respond in an appropriate and timely manner to the "Notice to File Missing Parts of Nonprovisional Application" ("Notice") mailed August 23, 2001, which indicated that a proper declaration under 37 CFR 1.63 was missing. The Notice set forth a shortened period for reply of two months from its mailing date. No response was received within the allowable period and the application became abandoned on November 24, 2002.

Consideration under 37 CFR 1.47(a)

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration **after having been presented with the application papers (specification, claims, and drawings)**;
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and,
- (4) a statement of the last known address of the nonsigning inventor.

Petitioner lacks item (1) as set forth above.

As to item (1), the evidence provided with the instant petition does not indicate that the complete application papers were presented to the non-signing inventors. Rather, the transmittal letters indicate that only the Declaration and Power Attorney were presented to the non-signing inventors. The conclusion that the subject inventors have constructively refused to join the application cannot be reached because it does not appear that the non-signing inventors have had the opportunity to review the entire application. The non-signing inventors can not be deemed to have made an intelligent decision not to join a patent application that they have not had an opportunity to review. Any renewed petition filed must, therefore, provide evidence that the non-signing inventors have, indeed, been presented with a complete copy of the

application papers for their review.

Deposit account 19-5425 will be assessed \$130.00 for the instant petition fee.

Consideration under 37 CFR 1.137(b):

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of this issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d) required pursuant to 37 CFR 1.137(c).

The present petition does not satisfy item (1).

As to item (1), petitioner has failed to submit the required reply to the "Notice to File Missing Parts of Application" of October 6, 1999. Petitioner must either file a declaration signed by all of the inventors or a grantable petition under 37 CFR 1.47(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, Virginia

Telephone inquiries should be directed to the undersigned at (703) 305-0010.

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